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Cases of Note -- Copyright: If You're in the Slammer, Are You in Service?

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LEGAL ISSUES



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Cases of Note — Copyright

If You're in the Slammer, Are You in Service?

by **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

Robert James Walton v. United States, United States Court of Appeals for the Federal Circuit, 551 F.3d 1367; 2009 U.S. App. LEXIS 113.

While doing time in the federal pen, our litigious inmate was set to the task of developing and producing desk-blotter calendars for a government-owned corporation. Said corp, **Federal Prison Industries, Inc.**, produces a variety of stuff for our bloated federal bureaucracy. And what a cost-saving measure it is. For this marvelous rehabilitative task, prisoners are paid in a range from \$0.23 to \$1.15 per hour. Our inmate's compensation is not part of the record. He did however decide to increase his income by a pro se suit for copyright infringement.

Which is to say he was his own lawyer.

Our inmate developed and produced quite a number of these calendars which the General Services Administration distributed to grace the Pinto Bean Desk in the Ag Department and other vital federal desks lined up in rows. He later acquired an attorney to guide him in this ever-so landmark case.

To sue the US for copyright violation, you go into the Court of Federal Claims. But right behind the jurisdictional grant in 28 U.S.C. § 1498(b) comes language that says you don't have a cause of action if your artistic creation was done (1) while you were in the service or employment of the US and (2)(a) where this was part of your job or (2)(b) you used Government time, materials or facilities.

This naturally got the complaint dismissed. But if you're doing time, you've got plenty of time for an appeal.

Court of Appeals for the Federal Circuit

First reread the "and" and "or" construction. Our inmate without question used federal computers thereby satisfying (2)(b). And he was assigned this task thus checking (2)(a). But was he in the "service or employment" of the US?

Inmate argued that § 1498(b) used the terms "employment" and "service" interchangeably. Thus they mean the same thing. And it is settled that prisoners are not employees. See,

e.g., Coupar v. U.S. Dep't of Labor, 105 F.3d 1263, 1265 (9th Cir. 1997); *Nicastro v. Reno*, 318 U.S. App. D.C. 72, (1996).

The US said where the heck did he get the idea the words were used interchangeably? Different parallel words used in the alternative just cries out different meanings. *Cf. Bowers v. N.Y. & Albany Lighterage Co.*, 273 U.S. 346, 349-50 (1927).

In *Bowers* the Supreme Court considered a bar on any "suit or proceeding" to collect taxes after five years of the tax return date. Proceeding is not synonymous with lawsuit. It can also mean distraint.

Which means seizing your property to wring out the money owed.



And to get a little more up to date, we have the cite of *FCC v. Pacifica Found.*, 438 U.S. 726, 739-40 (1978) holding "obscene, indecent, or profane" are three different words with three different meanings. Because it's "a cardinal principle of statutory construction that we must 'give effect, if possible, to every clause and word of a statute.'" *Williams v. Taylor*, 529 U.S. 362, 404 (2000).

Yes, Congress is not just trying to be verbose. Even if it seems that way.

Working in the pen under the direction of the guards constitutes being in the service of the US.

Copyright — When You're a Creative Soul, Everyone Wants a Piece of You

Crown Awards, Inc. v. Discount Trophy & Co., Inc., United States Court of Appeals for the Second Circuit, 2009 U.S. LEXIS 8540.

Crown Awards designed the ultimate must-have item — a plastic diamond-shaped spinning trophy! Aww-right! Can't you see that in your knotty pine-paneled den?

If only Dustin Hoffman in the Graduate had come up with this idea, all of his emotional problems would have been solved. But keep plastic in mind. It's a key point in the case.

Naturally, others were envious of the wild consumer demand for this superlative work of art and wanted to sell it themselves. Enter **Discount Trophy** which put their own plastic spinning diamond trophy on the market and of course were sued for copyright infringement.

After a two-day bench trial, **Crown Awards** was handed \$22,845.18 in damages. And their lawyers made out like bandits with \$165,528.01 in attorney's fees.

There's a big moral there, but I'm not sure what it is.

The Appeal

To win, you have to demonstrate a valid copyright — which **Crown** had — and infringement. The second bit requires proof of actual copying and a substantial similarity with the protected elements. See *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 110.

As proof of access for the purpose of copying is hard to show, it suffices for the plaintiff to show the alleged infringer had a "reasonable possibility" of access to the original work. *Jorgensen v. Epic/Sony Records*, 351 F.3d 46, 51 (2d Cir. 2003). "A court may infer that the alleged infringer had a reasonable possibility of access if the author sent the copyrighted work to a third party intermediary who has a close relationship with the infringer." *Id.* At 53 (quoting *Towler v. Sayles*, 76 F.3d 579, 583 (4th Cir. 1996).

And what was our access to **Crown's** design? **Discount** received **Crown's** 2006 Catalog and regularly monitored **Crown's**

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Questions & Answers — Copyright Column

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QUESTION: *How does the Americans with Disabilities Act (ADA) affect copyright? A university librarian asks about reproducing a dissertation in a large print or digital version for use by a visually impaired student.*

ANSWER: Congress has never done anything to harmonize the two acts, *Copyright* and the *ADA*. However, section 121 of the *Copyright Act* permits “authorized entities” to make copies of nondramatic literary works in specialized formats for the blind or others with disabilities. The definition of “authorized entity” is somewhat problematic in this situation. The statute defines authorized entity as “a nonprofit organization or a governmental agency that has a primary mission to provide specialized services relating to training, education, or adaptive reading or information access needs of blind or other persons with disabilities.” University libraries would not qualify under this definition.



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products. But — **Discount** bought the trophy from **Xiamen Xihua Arts and Crafts** (“**Xiamen**”) and there was no evidence that **Discount** asked **Xiamen** to manufacture the **Crown** design.

It's not clear, but it would seem that Xiamen is in China and therefore not a defendant.

Discount put forward the defense that **Xiamen** independently created the design. The District Court found the credibility of **Mr. Lin**, **Xiamen's** owner was — I love this — “non-existent.” And to quote the learned judge:

“I find it completely incredible that **Mr. Lin** who operates a company that makes resin products and who has no production capability to make plastic products would suddenly get it into his head to create a plastic trophy, let alone a trophy that would look like this particular trophy. I find it utterly incredible that **Mr. Lin** would subcontract out the making of extensive molds purely as a speculative venture for a totally novel product for his business without having any customers for the product.”

And it gets better. **Discount** is **Xiamen's** only US customer. It was “absolutely impossible” to believe **Xiamen** did this without coordinating with **Discount**. 🌿

Many academic and public libraries, produce large print or digital copies of works for the use of individual patrons who have disabilities. One can argue that if such a version does not exist, reproducing the work in a format that the patron can use fall under section 108(e) of the *Act* which permits libraries to reproduce a substantial portion of a work or even an entire work after the library has tried to obtain a copy of the work at a fair price for the patron to use. The copy must become the property of the user, the library must have no notice that the work will be used for other than fair use purposes and the work must contain the notice of copyright. Although currently the *Act* is silent about making a digital copy of a work in lieu of a photocopy, but many libraries are doing so under the same conditions as they produce photocopies for users.

QUESTION: *A public library has acquired two new sewing books and both come with a packet of sewing patterns. Would it be infringement for the library to place a note on the packets asking patrons not to cut the patterns but to trace them for their personal use instead? Or would it be preferable for the note to ask users not to cut the patterns and to leave them to their own devices to figure out what to do after that?*

ANSWER: Under the first sale doctrine in section 109(a) of the *Copyright Act*, after anyone (including a library) obtains a copy of a work in its collection, it may choose to lend these materials to others. Instructing users not to deface the work, which is what cutting the patterns would do, would not be infringement. Fashion design is not protected under United States copyright law, but patterns are graphic works and typically are protected. Thus, duplicating dress or crafts patterns via tracing or by another method likely is infringement. So the library should not advise tracing as it would encourage infringement.

QUESTION: *A library in a botanical garden has a large archival collection of photographs, many of which are quite old. Unfortunately, the photographer is not always identified or apparent but some were clearly created by a studio/professional photographer and are marked with attribution. For others the provenance is unclear. In some cases the library has the negatives but in other instances the photographs appear to be copies of copies. (1) Does the library own the copyright in the photographs in its collection? (2) If not, how can the library sort out the copyright issues for photographic images acquired over many years? (3) How can the library create a digital archive of these photographs that is available to the public without infringing copyright?*

ANSWER: (1) Ownership of the tangible item, the photograph or negative, is ownership of a copy, which may be the only copy of the

work in existence. This is absolutely separate from ownership of the copyright. The only way an institution owns the copyright in a photograph is if the photographer or other copyright owner transferred the copyright to the library in writing. Most likely, the library owns the copy but not the copyright. (2) If the photographs were published before 1923, however, they are in the public domain. So publication is the important question. If a photograph was never published, it entered the public domain at the end of 2002 or life of the photographer plus 70 years whichever is less. So, the library should make this determination and seek permission from photographers identified on the photographs. Those with no provenance are more difficult.

Creating a digital archive of these photographs would be very useful both to the library and to the public. (3) While creating a digital copy of some of these photographs may be infringement, in all likelihood, there is little risk. Many digital collections of photographs include a disclaimer to the effect that the copyright status of these works is presumed to be public domain due to the age of the work. If someone has other knowledge, that individual is invited to contact the library with that information.

QUESTION: *How does one prove that that he or she has permission to copy (generic for reproduce, perform, display, etc.) a copyrighted work? Must one have a signed document to that effect?*

ANSWER: Any written document can serve to prove that permission to copy was received. A letter that is signed is great, but other writings can also establish proof. If one obtains permission over the telephone, a confirming follow up memo to the copyright owner restating the permission he or she granted over the telephone is useful.

QUESTION: *Can cataloging data published online by a subscribing library be considered protected and not available to other institutions?*

ANSWER: The easy answer is no; not everything is eligible for copyright protection. Section 102(b) of the *Copyright Act* states: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” This includes facts. Individual bibliographic records are primarily factual in nature and therefore are not protectable. A bibliographic database is a collection of facts, and one that is a total universe of data is not protectable. On the other hand, a collection of bibliographic records such as in a subject bibliography, are protectable as a database created as a selection of material. 🌿